

**REMARKS/ARGUMENTS**

**AMENDMENTS**

1. Claim 2 has been amended to further clarify various relationships that exist among the various features of the claims of the present invention. In particular claim 2 has been amended to clarify that the rack of the present invention is a non-folding rack with horizontally disposed flanges that extend in a horizontal direction, and wherein the shelves of the device attach to the back and sides of the rack. Support for these amendments is found throughout the specification and particularly in figure 1 of the application as filed. These amendments add no new matter to the specification, and require no additional searching on the part of the Examiner, these amendments are intended to merely clarify positions which were asserted by the Applicant previously.

***Claim Rejections 35 USC §103***

2. The Examiner has rejected all of the claims of the application as being unpatentable over Temple, U.S. Patent No. 2,680,522 in view of a variety of other references.

3. The Examiner has also rejected all of the claims of the application as being obvious in view of a variety of combinations of references that include the Ochs reference together with these same additional references.

4. In the last Office Action the Applicant amended the claims of the application and included various arguments and remarks that were directed as to how the claims of the application are not rendered obvious in view of the combinations that had been made by the Examiner using the Temple and Ochs references.

5. The Examiner has now responded to the Applicant's previous arguments, indicating that the Applicant's arguments are unpersuasive and making various claims with regard to what features are and are not disclosed in the Temple and Ochs references.

6. After carefully reviewing the Examiner's response, Applicant fails to see how the Temple and Ochs references include each and every feature that is recited in the claims of the present application.

7. Referring first to the Temple reference, the Examiner indicates that the Temple reference includes each and every feature of the present invention as set forth in claim 2 of the present application, except for the presence of a cassette with a hinged lid and that the Spencer device

teaches this feature. Similar arguments are made involving the combination of the Ochs and the Spencer references.

8. When presented with the position that the Temple and Ochs references failed to include each and every feature from the present invention and particularly that these references failed to include the horizontally disposed flanges having holes that are attached to the tops of the opposing side walls, the Examiner responded that these items were disclosed in these references.

9. The Examiner asserts that the Temple reference includes a rigid transport rack which has a pair of horizontally disposed flanges attached to the tops of opposing sidewalls (Figure 3:28, 18 and 17) each of the flanges having a hole therein (28 in Figure 3 has unlabeled hole within in it).

10. However a review of the Temple reference itself (a marked up copy of the figures are shown in the attached Exhibit) shows that there are no flanges connected to the top portions of the opposing walls as the plain language of the claim requires. Furthermore, the items that the Examiner has asserted to be flanges, are not only not connected to the top of the opposing walls, they also fail to be horizontally disposed or to contain any holes therein.

11. Furthermore, the shelves in the Temple references are folding wire racks that are configured to hold cigarettes upon folding shelves and have no connection with the opposing sides of the rack. These items are made from wire and as such do not have true sides or surfaces but more correctly form a support structure upon which the cigarette cartons can be placed. The shelves (items no 11-15) are pivotally connected to the back of the device and are not configured for, nor do they intersect or connect with the sides of the device.

12. The elements which have been described by the Examiner as being flanges 28 are identified in the specification of this reference as supplemental frame portions 28 which are connected within the frame portions 17, 18 (see col. 2 lines 43-49). These items 28 are not horizontally disposed as is required by the claims of the present invention, are not attached to the tops of the opposing sides, as is also required by the express language of claim 2 and all claims that depend therefrom, nor are there any holes present within these supplemental frame portions.

13. Applicant has further amended claim 2 so as to require that the shelves are in contact with the opposing sides and the back of the device, and that these flanges are not only horizontally disposed but that these flanges also extend in a horizontal plane. The Temple device also fails to include these features.

14. Upon this base formed by the Temple reference, the Examiner has proceeded to add various references together to attempt to obtain combinations that include all of the features

which are set forth in the claims of the present invention. For example the Examiner has combined the Temple reference with the Spencer reference with the Williams reference, the Remington reference, the Rouse and Jerge references, the Kudla reference and other references.

15. However, the fundamental description of the Temple reference upon which the Examiner has constructed these rejections is flawed. The Temple reference simply does not contain all of the features, which are set forth in the claims of the present invention, and the combination of this reference with various other features still fails to meet all of the designated requirements for these rejections. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

16. This same fundamental flaw exists with the Ochs reference. While in the previous correspondence, the Applicant indicated that the Ochs reference failed to teach all of the features which are set forth in the claims of the present invention, the Examiner has responded arguing that the Applicant is in error and that the Ochs reference teaches a rigid transport rack that includes a pair of horizontally disposed side flanges (unlabeled horizontal bars in side walls 12 of Fig 1 connected vertically to each other with hooks 21 on both sides of the rigid transport rack) attached to the tops (figure 1:9 and 16) of the side walls (Figure 1:12) where each of the opposing flanges has one hole therein (hole within the side flange of unlabeled horizontal bars in the sidewalls 12 of Figure 1 to connect vertically to each other with hooks 21.

17. However, a review of the attached drawing from the Ochs device clearly shows that all of the features of claim 2 are not present in this reference. The Ochs device does not have horizontally disposed flanges with holes that are connected to the top portion of the sides see Exhibit 2. These features are however, shown in the attached Figure 1 from the present application see Exhibit 3. A simple comparison of these two items clearly shows that the claimed features which are present in the pending application are not present in the Ochs reference. Inasmuch as the Ochs reference fails to include these features, combinations of references which contain the Ochs reference fail to include each and every feature which is set forth in the claims and thus a prima facie case of obviousness has not been made.

18. In view of the fact that the combination of references which has been cited by the Examiner fails to teach or include each and every feature which has been set forth in the claims of the application, Applicant respectfully submits that the present invention is not an obvious modification of the prior art and that the Examiner has failed to make a prima facie case of obviousness with regard to any of the combinations of references that include the Temple reference and Ochs references. These references simply do not contain all of the features that the Examiner alleges that it contains and as such, a prima facie case of obviousness has not been made.

19. In addition to these grounds, there is no motivation or suggestion in the prior to make various modifications which the Examiner has suggested.

20. A fundamental requirement for the finding of obviousness is that there must be a suggestion or motivation within the references themselves to teach doing what the Applicant has done. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

21. A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000), Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide a motivation to combine references).

22. In this instance there is no motivation to combine the references which have been set forth by the Examiner, nor is there any suggestion or motivation to combine these references or items in the way that has been described in the present application.

23. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicant's specification.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has stated previously that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

*In re Fritch*, 972 F.2d 1260, 23 USPT2d 1780, 1784 (Fed.Cir. 1992), (in part quoting from *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

24. To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.* 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

25. In present circumstance there is no motivation or suggestion to combine the numerous references which have been combined by the Examiner against the present invention. Even if combined, this combination fails to include each and every feature of the present invention and thus a prima facie case of obviousness has not been made.

26. In view of these amendments and discussion applicant respectfully submits that the present invention is not taught by the prior art, and that the Examiner's combinations fail to establish the presence of a prima facie case of obviousness.


### ***Conclusion***

Reconsideration and allowance of the application as amended is respectfully requested.

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

DATED this 30th day of June, 2006

Very respectfully,

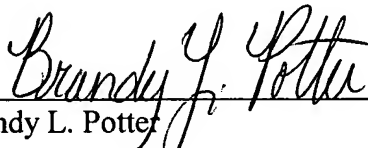
  
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CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

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Brandy L. Potter

**EXHIBIT**

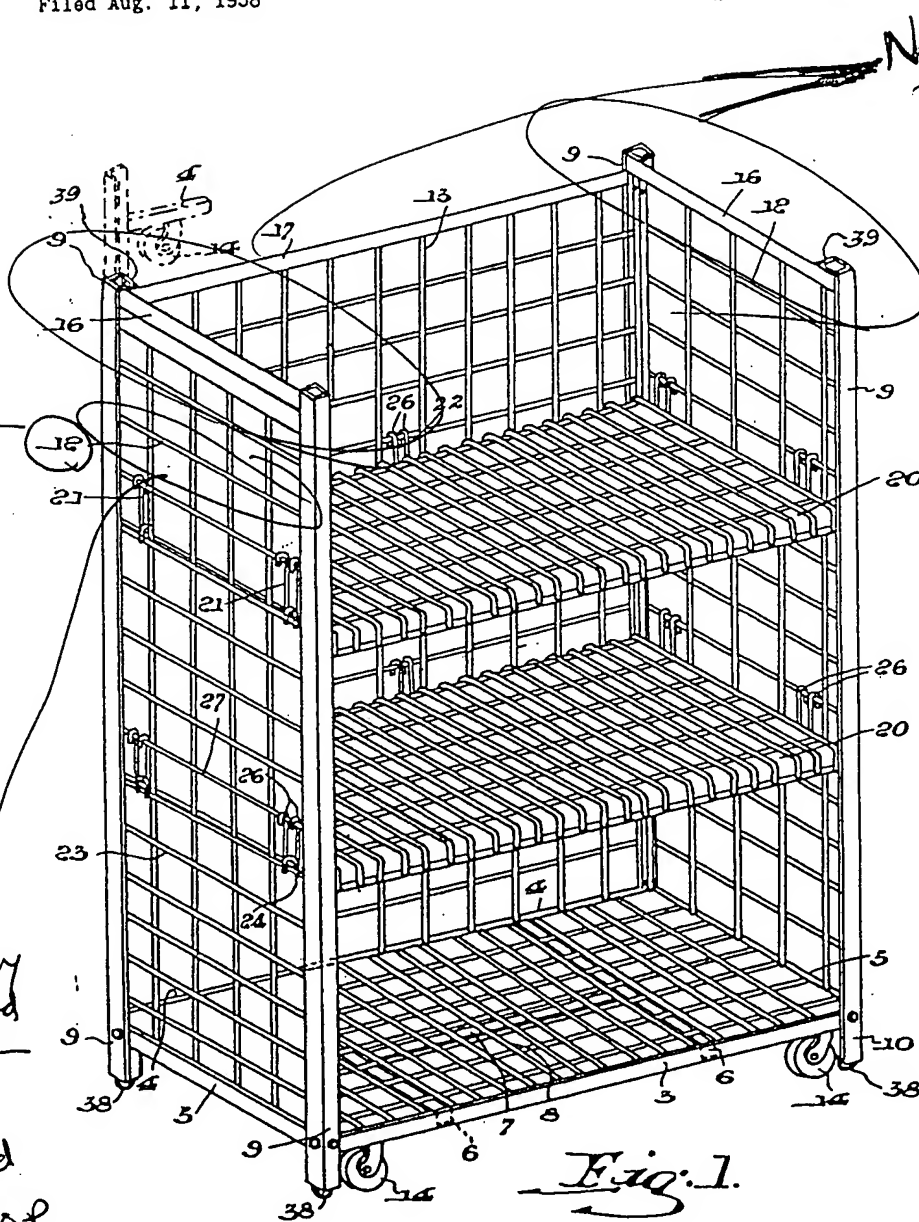
Nov. 7, 1961

W. F. OCHS  
STORAGE RACKS

3,007,708

Filed Aug. 11, 1958

2 Sheets-Sheet 1



No Horizontally  
Disposed  
flanges. Positioned  
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Fig 1 from Application.

Fig. 1.

INVENTOR  
WILLIAM F. OCHS  
BY Andrew Martin  
his ATTORNEY.





